

MANFRED T. REETZ ET AL.  
USSN 09/831,566  
REPLY TO OFFICE ACTION DATED MAY 17, 2004  
AMENDMENT OF OCTOBER 18, 2004

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Amendments have been made to claims 24, 25, 30 and 31 to overcome the rejection of these claims under 35 USC § 112, second paragraph. A mark-up showing the changes that have been made to these claims using strikethroughs and underlining appears above.

The disclosure was objected to because of certain informalities. In response, Applicants respectfully request that these be held in abeyance until allowable subject matter is indicated.

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See, 37 CFR § 1.111 (b) ("If the reply is made with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated.") The indicated corrections needed in the specification do not touch the claims, and, therefore, Applicants request is appropriate to have these corrections delayed until allowable subject matter is indicated.

Claims 21-45 were rejected under 35 USC § 112, first paragraph, as containing new matter. In response, Applicants point out that the inventive colloids are claimed to be soluble in 100% water, i.e., not containing any organic solvents, and, therefore, are correctly designated as "100% water-soluble." This point was made in the second paragraph on page 4 of the amendment dated May 27, 2003:

"[O]ne of the main objects of the present invention was to avoid the use of such organic solvents, and, indeed, *the inventive colloids are stable in 100% water.*"

[Emphasis added.] As explained in the first full paragraph on page 5 of that same amendment, the specification shows the colloids obtained are completely dispersible, and, therefore, soluble, in water alone, i.e., 100% water.

Consequently, the specification does, in fact, support the claim language of "100% water-

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soluble." Accordingly, the claims do not, in fact, contain any new matter. Moreover, this language distinguishes the instant colloids from those of Moumen, since Moumen's colloids are soluble only in water containing large amounts of organic solvents, i.e., Moumen's colloids are not soluble in 100% water.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 24, 25, 30 and 31 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants have amended these claims to eliminate the need for antecedent basis.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

For the record, Applicants emphasize that although the claims were amended to overcome this rejection, and, therefore, might be argued to have been amended for a reason substantially related to patentability, a fair reading of the amended claims will reveal that the

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departures from the previous claims were for clarification purposes only, and that Applicants did not narrow the claims in any material respect. Therefore, Applicants submit that the amended claims are entitled to the full range of equivalents.

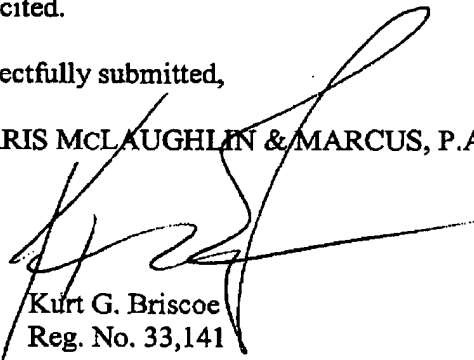
Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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By

  
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 and the accompanying Petition for Extension of Time (14 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: October 18, 2004

By:

  
Kurt G. Briscoe